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EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/471,357

Applicant(s)

NABESHIMA ET AL.

Examiner

Vincent F. Boccio

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 11-18, 21-58 and 65-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10, 19, 20 and 59-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Applicant's arguments filed 7/28/04 against the amended claims, have been fully considered but they are not persuasive. {A} In re page 28, applicant states, "Butler's receiver does not include instructions or data for changing reproduction control content based upon a comparison of recording and reproduction environment information, claim 10".

In response since the claims recite, transmitter device, comprising a transmitting that transmits, recording environment information, interpreted to read on page 5, col. 1, recites,

"control data such as timing parameters along the video stream", during a playback from media and reception from a tuner, this information can be interpreted as,

"recording environment information", being timing parameters in a reception, or a recording, which are same parameters during reproduction of a recording, wherein according to page 5, col. 2, which Butler is adapted to and does meet the claim language of a transmitting device transmitting a stream, which changes the reproduction control environment based on media time/times and reproduction environment information (overlay specified times), page 5, col. 1, "overlays are displayed at the times indicated by the timing specifications contained in the control data, rather than at the time that are received", therefore, the media time or timing parameters along a video stream are used as the triggers for the overlays with respect to a table of overlays with corresponding time parameter associated with an overlay, either prerecorded or at least cached content, wherein the transmitter is adapted to transmit this information (page 5, col. 2, "broadcast overlays files during the night to user equipment).

Therefore, the receiving equipment compares, transmitted from the transmitting device,

the media times (which times are and meets the limitation of, "recording environment information"), with overlay times, to trigger a change in the reproduction environment with the reproduction environment information (the overlays in combination with the video rendering or reproduction).

{B} In re page 28, applicant states, "Applicants can find no passage within Butler that discloses any type of recording."

In response, what type of recording is required by the claims??

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Further, the examiner cannot agree with the statement that Butler does not do any type of recording, Butler clearly records forms of content and control data from the broadcast met by the overlays and control data for the overlays, further as suggested by Fig. 2, suggests recording to VCR 74, HDD 146, although the claims never directly claimed a recording operation, merely claiming, recording and reproduction environment information.

Further, in accord to claim 10, only requires the transmitter to transmit content and {instruction or data for changing the reproduction control content, which read on the overlay and such as, control timing parameters, or met by the image of the overlay and the code allowing a user to interact with the overlay, which is a hyperlink overlay when selected changes the reproduction rendering representation to the user after selection of the hyperlink, presented at times indicated by the control data is responsible for this, also to render an overlay to be transparent also requires additional control data, as well as the overlay itself, also disclosed by Butler.

{C} In re page 29, applicant states, "Applicant's cannot find any discussion regarding, for example a second set of conditions or instructions that are applied when not in reproduction".

In response, the examiner fails to agree, with respect as discussed above, since the transmitter is adapted to send, overlays being one of content sent, with data allowing for interaction, which there seems to be three modes of operation,

- first and second modes of operation, are tuned and receiving modes, wherein overlay content, with data hyperlinks are rendered providing means for the user to interact with,
- first mode renders at times received; and
- second mode renders with additional control information timing specifications (page 5, col. 1, [0055], "As a result");
- third mode of operation is prerecorded media and using the second mode, but, local reproduction, using the times, deemed suggested to use the media time, wherein the second mode can use the

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broadcast time to trigger overlays, as understood after a careful consideration of Butler, by the examiner, deemed to be clear to those skilled in the art.

{D} In re page 30, applicant states, "Butler does not include a program/script", wherein applicant respectfully requests a reference.

In response the examiner agrees, but, had taken notice of this point and will supply a reference and discussion with respect to this point.

Further as noted by the examiner, did not deliberately make the attempt to suggest script with respect to different modes, but, merely that script can be associated with HTML, wherein Butler as discussed above anticipates more than one mode, such as two reception and one reproduction mode of operation, wherein the overlays, control data, including the HTML with script, the different control content is reflected by the two different reception modes, which the reproduction mode is different content data that at least one of the reception modes disclosed by Butler.

{Mode 1}, reception, render overlays as they are received;
{Mode 2}, reception, render overlays with respect to media time and for example a local or broadcast clock;
{mode 3}, local reproduction of media, rendering overlays with respect to recording environment, met by the recording's media times, to trigger the overlays at the time the user decides to reproduce the media, there must be media time or recording environment information.

In response in accord to page 4 of the examiner's last action, stated that Butler discloses two modes, and interpreted program/script to be program script, which is deemed to read on wherein the HTML from the overlay URL address, can have script.

As interpreted, with respect to the content and control content, being representative of the overlays, hyperlinks and the corresponding HTML from the URL addresses, the examiner had rendered obvious script in HTML.

The examiner provides a supporting reference US 6,081,837, Stedman et al., teaches that it is well known as of filing date 12/9/1996, in the, section, "Background of the invention", col. 2, lines 16-30,

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"JavaScript is a scripting language that is used to extend the capabilities of HTML. JavaScript is capable of recognizing and responding to events, such as mouse clicks and movements, generated by the browser program. JavaScript scripts are embedded in HTML documents. The browser executes the script as it reaches the position of the script during the interpretation of the HTML documents.", therefore, since Butler teaches page 5, col. 2, HTML files, it is rendered obvious to utilize Script, such as JavaScript, just one of many type of scripting languages, to extend HTML, as desired.

Therefore, it would have been obvious to those skilled in the art that the content data received can include script allowing for dynamic capabilities of interaction thereby extending the capabilities of HTML, with JavaScript, as taught by Stedman, as is obvious to those skilled in the art.

Therefore, Butler does provides reception modes and reproduction modes of operation, wherein the claims fails to claim recording, but, merely reference, "recording environment information".

{E} In re applicant states, "different control content in reception mode -vs.- reproduction mode is non-obvious and could only be arrived thru hindsight".

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

2. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "recording") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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As clearly understood by the examiner Butler provides for two reception modes and one reproduction mode with overlays which after a careful analysis, Butler anticipates the concept, of and deemed to be modes:

- tuned signal overlays triggered as received;
- tuned signal with overlay triggered in view of "timing specifications contained in the control data", and
- reproduced signal of a media, being a playback of recorded, triggering overlays in view of media time, as understood by the examiner, which is deemed clear to those skilled in the art.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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2. Claims 10, 19-20, 59-64, are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493, FD 7/1997).

The examiner incorporates by reference the previous action against the claims, wherein the amendments to the claims do not overcome significantly change the scope of the claims against, the prior art as now applied, this response to statements made by applicant, as interpreted against the amended claims in view of the statement made.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Fax Information

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

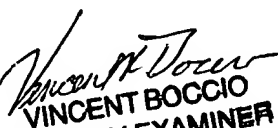
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Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent
1/10/05


VINCENT BOCCIO
PRIMARY EXAMINER